

REMARKS

The Applicant appreciates the courteous and complete examination of the application by the Examiner. In view of the foregoing amendments and the following remarks, a reconsideration of the instant application is respectfully requested.

In order to expedite the prosecution of this application claims 1 and 3 have been amended. Claims 1-11 are now in this application.

Regarding the Claim § 112 Rejections

The Examiner rejected claims 4-11 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner states "New claim 4 recites that the inner surfaces have spherical projections and indentations. The specification does not describe these features on the inner surfaces."

Claim 4 was amended, in a non-entered after final amendment dated 10/07/2008, to delete the language which associates the spherical projections and indentations with "the inner surfaces", which would have overcome this rejection. The Examiner stated that the deletion of this feature would make claim 4 broader and raise new issues. The Applicant respectfully believes that claim 4 is allowable and patentable of the prior art reference, as stated herewithbelow. The Applicant requests that the Examiner reconsider his rejection and allow for the deletion of the above-identified feature so that claim 4 can be put in condition for allowance.

The Examiner rejects claims 1-11 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite for the reason noted in the above paragraph pertaining to the 35 U.S.C. § 112, first paragraph rejection. Specifically as noted above with regards to the rejection under 35 U.S.C. § 112, first paragraph, claim 4 has not been amended to overcome this rejection since the Examiner states that it would raise new issues.

Claim 3 was rejected under 35 U.S.C. 112, second paragraph, because the term "and" on line 2 should be changed to "or". Claim 3 has been amended as requested by the Examiner.

Claim 1 was specifically rejected under 35 U.S.C. 112, second paragraph, because the Examiner feels that claim 1 remains confusing in lines 14-25 thereof.

Claims 1 has been amended to remove all confusing language, as requested by the Examiner. Specifically, lines 8-20 directed toward the "elastic consoles" has been amended to clearly claim that the elastic consoles are rectangular plates formed by slots defined on three sides thereof with a forth side of the elastic consoles being connected to the lower portion. Additionally, the phrase "the root" has been changed to "a root" thereby introducing the root element and thereby providing sufficient antecedent basis.

Furthermore, the phrase "cab be inserted with tooth of other cases" has been amended to read "can be inserted with the tooth of elastic consoles of other cases", thus clearly associating the tooth with elastic consoles.

The Examiner states that "claims 1-3 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2 second paragraph". The Applicant respectfully believes that the amendments to claim 1 and 3 comply with all the Examiners requests and overcomes all rejections, and is thereby believed to be in condition for allowance.

Regarding the Claim § 103 Rejection

The Examiner rejects claims 4-11 under 35 U.S.C. 103(a) as being unpatentable over Byrne et al. The Examiner states that the Byrne "lacks protrusions and indentations for helping to stack the cases", but "it would have been obvious in view of Byrne to provide the device disclosed therein with the missing features".

Since, by the Examiner's own admission, Byrne does not disclose, teach or suggest the use of "at least one spherical projection adjacent each corner" that is adapted to be received by a corresponding "spherical indentation adjacent each corner",

and in combination with the below stated court rulings, it is respectfully believed that claim 4 is patentably distinct therefrom.

Furthermore, Byrne does not disclose, teach or suggest the use of "elastic consoles adjacent to each corner" and "stepped slots located adjacent each corner" adapted to receive a corresponding elastic console. The pair of snap tabs (32), latches (36) and slots (38) of Byrne are not located adjacent each corner and are only located and extend out from the primary page (14, 16) [fig. 8, col. 2, lines 48-55]. As in claim 4 of the present invention, the elastic consoles and stepped slots are adjacent to each corner and therefore part of the internal structure of their respective upper and lower portion, which is believed to be substantially structurally different from Byrne. Additionally, Byrne does not disclose the slots (38) being stepped, as described in claim 4.

It can be appreciated that since Byrne does not disclose, teach or suggest the use of spherical projections and indentations, and that the pair of snap tabs, latches, and slots of Byrne are structurally different from claim 4, it is believed that claim 4 is not obvious in view of Byrne. Claims 5-11 are felt to patentably distinguish over the prior art references because of their above-mentioned dependency from amended claim 4.

Regarding claim 9, the snap tabs (32) of Byrne are not formed by "a slot defined from three sides therefore producing a free end". The snap tabs (32) are latches that extend out from the primary page (14, 16) [fig. 8], and therefore it can be appreciated that the elastic consoles of claim 9 are structurally different and not obvious by Byrne.

Regarding claim 10, Byrne does not disclose, teach or suggest that the snap tabs (32) are "initially inclined at an angle towards the inner surface" of the primary page (14, 16), as described in claim 10.

However, as the Supreme Court recently explained "a patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S., 82 U.S.P.Q.2d 1385, 1396 (2007). Moreover, "[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006) cited with

approval in KSR). "To facilitate review, this analysis should be made explicit." *Id.* Furthermore, "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. See Graham, 383 U. S., at 36 (warning against a 'temptation to read into the prior art the teachings of the invention in issue' and instructing courts to 'guard against slipping into the use of hindsight' (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (CA6 1964)))." *Id.* at, 82 U.S.Q.P.2d at 1397.

Additionally, since the Byrne reference does not suggest, teach, or show any motivation to use spherical projections and indentations, and of elastic consoles formed by slots on three sides to produce a free end, then it can therefore be appreciated that this reference is not a proper basis for the § 103 rejections. See e.g., *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Therefore, the modification of the Byrne reference does not render the resultant modification obviousness since the Byrne reference does not suggest the desirability of the modification.

Moreover, the law is clear that a motivation must be provided by the prior art to make the allegedly obvious combinations of parts relied upon in making an obviousness rejection. Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 140, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). And, absent such a showing of motivation in the prior art to make the allegedly obvious combination, it can only be assumed that the applicant's

disclosure has provided the motivation for making the combination of elements from the prior art, and not the prior art itself.

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight. See e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). It is therefore submitted that the combination of individual parts taught by the various prior art references relied upon in the Office Action would not motivate one skilled in the art to arrive at the applicant's claimed invention.

Regarding the Previously Filed Request for Withdrawal as Agent

A Request for Withdrawal as Agent was inadvertently filed on 09/05/2008 and was done in error without any deceptive intent. A new Power of Attorney signed by the inventor is submitted herewith.

Conclusion

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Applicant has endeavored to address all of the Examiner's concerns as expressed in the Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the

above-remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the clarity of the claims to particularly and distinctly point out the invention to those of skill in the art. Finally, Applicant submits that the claim limitations above represent only illustrative distinctions. Hence, there may be other patentable features that distinguish the claimed invention from the prior art.

With the above amendments being fully responsive to all outstanding rejections and formal requirements, it is respectfully submitted that the claims are now in condition for allowance, and a notice to that effect is earnestly solicited. Should the Examiner feel that there are further issues which might be resolved by means of telephone interview, the Examiner is cordially invited to telephone the undersigned at (403) 444-5695, or by email at davidguerra@internationalpatentgroup.com.

A one month extension of time fee of \$65.00 is provided.

Respectfully Submitted,

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